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EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/827,554		WORKENS, MONICA L.	
	Examiner		Art Unit	
	Daniel I. Walsh		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14, 16, 17 and 25-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 14, 16, 17 and 25-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 8-17-06.

Claim Objections

2. Claims 1, 10, 13, 25-30, 32-34, 36-41, 43-45, 48-51, and 64 are objected to because of the following informalities:

Re claim 1: Replace “account(s)” and “identifier(s)”.

Re claim 1: Replace “being operable to store” with – stores --, in order to have a positive limitation.

Re claim 1: Replace “selected account” with – chosen account –

Re claim 10: Replace “to have the ability to copy” with – copying – to have a positive limitation.

Re claim 13: delete “operable to handle multiple account identifiers” so the claims makes better sense.

Re claim 25: Delete “operable” and replace “to facilitate” with – facilitates --.

Re claims 26-30: Replace “operable to send” with – sends --.

Re claims 32-34 and 36-39: Replace “is operable to initiate” with – initiates –

Re claim 34: Replace “first server of selected account” with – server of the selected account –

Re claims 40: Replace “at least one account” with – at least one first account –

Re claim 40, 41, 43-45, 48-51, and 64: Replace instances of “operable” in the manner as discussed above.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 65-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose the claimed limitations of “providing individual and aggregated account transaction information completed through the system”, and the Examiner notes that the specification teaches funds transfer but does not teach such record keeping purposes throughout the system.

4. Claims 1-11, 13-14, 16-17, and 52-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner notes that the specification does not teach the claimed “whereby the individual institutions directly settle through their bank”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11, 13-14, 16-17, 25-40, and 52-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "the receiving institution" and "the user and sometimes non-user". For purposes of Examination the Examiner has interpreted this as the retailer and the cardholder.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "individual institutions" is vague/indefinite as it is unclear what is being referred to. For purposes of examination the Examiner has interpreted it as parties in the transaction.

Claim 65 recites "the system" which renders the claim vague/indefinite. It is unclear what constitutes the system (card, card reader, etc).

Claim 65 recites the limitation "the system" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 65-69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a judicial exception; as such, pursuant to the Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106)), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be a tangible result claimed. Merely providing information would not appear to be sufficient to constitute a tangible result, since the outcome of the providing step has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized. As such, the subject matter of the claims is not patent eligible.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 and 16-17, 52-55, and 58-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn (US 5,859,419) in view of Lim (US 2003/0061156).

Re claim 1, Wynn (US 5,859,419) teaches a card having a memory, the memory storing a plurality of account identifiers associated with accounts (col 4, lines 55+). The Examiner notes that in a transaction, it is obvious that an amount is communicated and that the user initiates funding of the item as is conventional in the art. Wynn teaches a PIN and selection of an account to use (col 6, lines 1+ and FIG. 16).

Wynn is silent to in response to receiving the payment information and request, that funds are transferred in real time from the first account on the card to the retailer or receiving institution directly, whereby the individual institutions directly settle through their bank, the respective side of the transaction.

Lim teaches that credit card transactions are settled directly (abstract). As funds are transferred from one account to the other account (settled instantly), this is broadly interpreted as the individual institutions directly settling through their bank, their side of the transaction.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Wynn with those of Lim.

One would have been motivated to do this for instant settlement, so that retailers don't have to wait (can receive funds for completed transactions instantly).

Re claim 2, the Examiner notes that as discussed above, instant settlement transfers funds to the retailer.

Re claim 3, the Examiner notes that the memory space of the card is interpreted to store data pertaining to the accounts, broadly interpreted as account identifiers, as it is obvious that a means to select an account would be an obvious expedient to distinguish different accounts.

Re claim 4, Wynn teaches card reader 202 which is interpreted as reading the account identifiers from a terminal device with a card reader. A terminal such as a POS terminal is an obvious expedient well known in the art, conventionally coupled with a card reader to facilitate completion of a card transaction (discussed in previous Office Action).

Re claim 5, the Examiner notes that by processing a transaction at a device/reader/terminal that a signal is generated which allows the transaction to be completed (funds withdrawn from one account and transferred to another). This is conventional in the art. Lim has taught the instantaneous settlement above.

Re claims 16-17 and 52, a PIN has been discussed above as a means for providing security, as is conventional in the art.

Re claim 53, the authorization has been discussed above. Banking transactions have been discussed above as well (FIG. 10, Table 4 of Wynn, for example).

Re claim 54, a non-banking transaction is discussed above (credit).

Re claim 55, as credit card transactions and instant settlement have been discussed above, it would have been obvious that funds are transferred directly.

Re claim 58, though silent to levying a fee for handling the funding of the transaction, the Examiner notes that it is well known and conventional in the art that fees are assessed for electronic card transactions, and typically the point of sale terminal/store pays the fees. Accordingly, fees for card-based transactions are an obvious expedient, as a means for paying for a convenience that a store can provide to its customers (electronic transactions). Additionally, fees are known to be levied at ATMs when different financial providers/bank accounts are being accessed.

Re claims 59-63, the Examiner notes that the claims are directed towards specific types of payments/transfers being made. Though the prior art is silent to such specific types of payments, the Examiner notes that self service terminals/ATMs as taught above, and as cited in the previous action are well known and conventional in the art for facilitating transfers, purchases, and payment of debt. The particular type of transfer/financial transaction is a matter of intended use. The Examiner notes that such terminals are known in the art to complete various financial transactions, and the completion of the specific type of transactions as claimed, would have been obvious to one of ordinary skill in the art, as a means to electronically complete a transaction at a terminal, where the terminal provides a convenience by permitting such various transactions to be completed. If the Applicant disagrees, a restriction can be enforced if the embodiments are patentably distinct and mutually exclusive, for example.

Re claim 64, the Examiner notes that a transfer of funds to a selected account can be interpreted as payment to a merchant, as disclosed above.

Re claims 65-69, the limitations have been discussed above. Though silent to a server/WAN, the Examiner notes that such limitations are an obvious expedient for distance communication over a network. As the prior art teaches storing transaction history, it would have been obvious for the merchant as well, to store aggregate (all transaction information) for record keeping purposes.

7. Claims 6-11,13-14, 56-57, and 65-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn/Lim, as discussed above, in view of Ramachandran.

The teachings of Wynn/Lim have been discussed above.

Wynn/Lim are silent to the means of populating/storing account identifiers in the card by scanning a barcode of a document (claim 6), scanning a barcode of an account statement (claim 7), scanning a barcode including a routing and account number (claim 8), storing the routing and account number (claim 9), copying information from a credit report to memory (claim 10), copying a routing and account number to memory (claim 11), importing information from a magnetic stripe of a card (claim 13), and importing a routing number and account number from a stripe of another card (claim 14).

Re claims 6-11, Ramachandran teaches a bar code reader to populate a card with account identifiers by scanning a barcode of a card (document), and storing the associated information into the card memory (paragraph [0033] and FIG. 43-52). Accordingly, Ramachandran is relevant to importing card information from barcode reading. The Examiner notes that the type of medium from which the barcode is read from, appears a matter of intended use. As Ramachandran teaches the structure to permit barcode information relating to cards to be stored, it would have been obvious to one of ordinary skill in the art to import such barcode information from well known documents such as account statements, credit reports, etc. As discussed in the previous Office Action, routing numbers and account numbers are well known and conventional in the art as being associated with accounts. Accordingly, when importing/saving account information, it would have been obvious to include such information, as a means to securely and uniquely identify the account. Re claim 13, Ramachandran teaches populating a memory of a universal card by electronically importing account information from a magnetic stripe on a card (FIG. 15-24). Re claim 14, as discussed in the previous Office Action, magnetic stripes can store such account identifying information in order to securely and uniquely identify the account.

At the time the invention was made it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Wynn/Lim with those of Ramachandran.

One would have been motivated to do this in order to have convenient ways of importing card information from different accounts.

Re claims 56-57, FIG. 63 teaches real time display of the information.

8. Claims 25-31, 32-46, and 47-51, and 65-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn/Lim, as discussed above, in view of Ramachandran.

The teachings of Wynn/Lim have been discussed above.

Wynn/Lim is silent to a point of sale terminal able to read a card with a plurality of identifiers on it, and selecting the desired account.

Ramachandran teaches consolidating a plurality of cards, including debit cards, into one card (abstract). It is understood that the card is usable at a point of sale, as the card ([0106]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Kakuta with those of Ramachandran.

One would have been motivated to do this to consolidate cards for user convenience. The Examiner notes that though silent to a server connected to a point of sale terminal, that it would have been obvious to have such elements in order to complete a financial transaction, as is conventional in the art. Re claims 26-30, the Examiner notes that such transactions are well known and conventional in the art for being performed electronically/through the use of a debit card, and appear to be matters of intended use. The prior art teaches the structure of a card being able to complete a transaction instantaneously (transfer of funds). The specific types of transactions are obvious to one of ordinary skill in the art, as the transactions themselves are

conventional and do not require a structurally different card, as understood by the Examiner. Therefore, one would have been motivated to complete such transactions based on their financial situations/needs, as the combination of references as taught above is relied upon to teach real time settlement of transactions. Additionally, if the Applicant disagrees and, a restriction may be enforced if the different embodiments of the systems as claimed in claims 26-30 are patentably distinct from each other and mutually exclusive. Additionally, noting that payments using a card are well known and conventional, one would have been motivated to use a card for such transactions, as an obvious expedient to pay off transactions.

Re claim 31, the Examiner notes it is obvious to one of ordinary skill in the art to read an account number from the card in order to process a transaction.

Re claim 32, Wynn teaches a banking transaction from a first account to a second account (TABLE 4).

Re claim 33, a non-banking transaction is interpreted as being a credit card, as discussed above.

Re claim 34, the Examiner notes that in networked transactions, it would have been obvious to one of ordinary skill in the art for a server to communicate in order to process transactions over a network.

Re claim 35, the Examiner notes that though the prior art is silent, it is understood that transactions with different institutions would involve different servers, and that those within a same institution could include a same server.

Re claims 36-39, the Examiner notes that a transfer of funds has been discussed above. A specific type of payment is an intended use and therefore not patentable. Additionally, the

Examiner notes that one would have been motivated to use a card to facilitate payment, for user convenience.

Re claim 40, the Examiner notes that the first account is selected to transfer funds to a second account (merchant) as discussed above in order to complete a transaction.

Re claim 41, the Examiner notes that the teachings have been discussed above. Though silent to a wide area network, the Examiner notes that wide area networks are well known and conventional to permit communication across distances. Accordingly, as the system described by the prior art is able to be used across distances, it would have been obvious to use a wide area network to facilitate such distance communications.

Re claim 42, the limitations have been discussed above re claim 31.

Re claim 43, the limitations have been discussed above re claim 32.

Re claim 44, the Examiner notes that it has been discussed above that with respect to a credit card transaction, a credit card center is contacted to verify the possible transmission of funds. This is interpreted as a financial services center, and the use of server has been discussed above to provide communications. Additionally, the Examiner notes that it would have been obvious to contact an authority associated with a source of funds, in order to verify a possible transfer of funds, where such a source can be interpreted as a financial services server.

Re claim 45, the limitations have been discussed above re claim 33.

Re claim 46, the limitations have been discussed above re claim 35.

Re claims 36-39, 47-50, the Examiner notes that the claims are directed towards specific types of payments/transfers being made. Though the prior art is silent to such specific types of payments, the Examiner notes that self service terminals/ATMs as taught above are well known

and conventional in the art for facilitating transfers, purchases, and payment of debt. The particular type of transfer/financial transaction is a matter of intended use. The Examiner notes that such terminals are known in the art to complete various financial transactions, and the completion of the specific type of transactions as claimed, would have been obvious to one of ordinary skill in the art, as a means to electronically complete a transaction at a terminal, where the terminal provides a convenience by permitting such transactions to be completed.

Re claim 51, the Examiner notes that the transfer of funds to accounts on a card has been discussed above.

Re claims 65-69, the limitations have been discussed above. Though silent to a server/WAN, the Examiner notes that such limitations are an obvious expedient for distance communication over a network. As the prior art teaches storing transaction history, it would have been obvious for the merchant as well, to store aggregate (all transaction information) for record keeping purposes, especially as Ramachandran also teaches transaction information stored on the card (FIG. 63). The Examiner notes that recording aggregate transactions is obvious in order for a vendor/retail establishment to keep records.

9. Claims 1, 25, 41, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakuta as discussed in the previous Office Action.

Kakuta teaches a card that stores an account and account identifier in a memory on the card, receiving a communication of an amount for purchase from the retailer, and the user initiates the funding of the sale of the item through a PIN and choosing an account to complete the transaction, where funds are transferred in real time to the institution directly and respective sides settle the transaction (abstract, and FIG. 1+, paragraph [0059]). The Examiner notes that

the claim language does not appear to require more than one account, as it is written as account(s). The Examiner notes, as discussed in the previous Office Action, that it would have been obvious for the amount of purchase to come from the retailer, and that by entering the code, the user is selecting their account. Though silent to individual institutions settling directly through their bank, as the accounts are settled instantly, it would have been obvious to do so in order to settle instantly.

Re claim 25, as discussed in the previous Office Action, the use of a server coupled to the terminal is an obvious expedient to settle transactions over a network (see FIG. 2).

Re claim 41, the limitations have been discussed above. A wide area network is an obvious expedient for distance communications over a network. The Examiner notes that the claims recite "operable to" and therefore is not a positive limitation, and just requires the ability to do so. Accordingly, the card appears operable to store a plurality of account identifiers, as its memory appears to have the ability to do so, and in light of consolidated cards (different accounts, it appears able to do so).

Re claims 65, the limitations have been discussed above. Though silent to aggregated account information, the Examiner notes that it would have been obvious to one of ordinary skill in the art that each user would have their own account information (history), such as via the printed receipts disclosed by Kakuta, and that it would have been obvious for the retailer to include aggregate transaction (all of their information) for record keeping purposes.

Response to Arguments

10. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Additionally, the Examiner notes that as Kakuta is drawn towards instant settlement, it is interpreted to update and verify in real time.

In response to the Applicants argument that Lim does not include a card, card reader, terminal, or network, the Examiner notes that to one of ordinary skill in the art, such components for a transaction are an obvious expedient. PIN's have been disclosed as used for security (see above action).

The Examiner notes that to expedite prosecution, the applicants arguments should rely upon features which the Applicant actually claims, as limitations from the specification are not read into the claims, and not merely state that the prior art and current invention are opposite. The Applicants arguments should not be a mere allegation of patentability, but should specifically point out differences between the prior art teachings and what is actually being claimed, and should not merely disclose what the prior art is teaching, either.

Additional Remarks

11. The Examiner notes that he is available for consultation/interview if the Applicant desires to expedite prosecution. The Examiners contact information is provided below.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

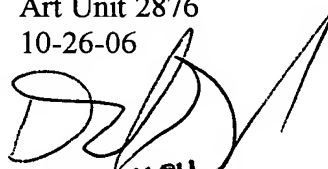
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Daniel I Walsh

Examiner

Art Unit 2876

10-26-06



DANIEL WALSH
PRIMARY EXAMINER